Attorney Docket No.: 050415

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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| Applicants: | Platner, Michael G. et al. | : | Examiner: Gold, Avi M. |
| Serial No.: | 09/943,891 | : | Art Unit: 2157 |
| Filing Date: | August 30, 2001 | : | |

Entitled: SYSTEM FOR GENERATING A WEB DOCUMENT

**PRE-APPEAL BRIEF REQUEST FOR REVIEW**

MAIL STOP AF
Commissioner for Patents
P.O. Box 1450
Alexandria, Virginia 22313-1450

Sir:

This paper is filed pursuant to the July 12, 2005 Notice in the Official Gazette entitled "New Pre-Appeal Brief Conference Pilot Program" and in accordance with the subsequent Notice of January 10, 2006 extending the pilot pre-appeal brief conference program until further notice. This paper is filed with a Notice of Appeal that is believed timely without the need for an extension. If further extensions are necessary to make this Request timely, kindly grant them and charge the fee for same to Deposit Account No. 02-4800, in the name of Buchanan Ingersoll PC.

Claims 2, 5, 8, 10, 24, 25, 30, 33, 34, and 36-41 are pending and stand rejected under 35 U.S.C. § 103(a) for alleged obviousness in light of one or more of U.S. Pat. No. 6,026,433, to D'Arlach, et al.; U.S. Patent No. 6,119,078, to Kobayakawa et al.; U.S. Pat. No. 5,732,231, to Evans, III; U.S. Pat. No. 6,560,639, to Dan, et al.; U.S. Pat. No. 6,317,791, to Cohn, et al. Claim

40 stands rejected under 35 U.S.C. § 112 for alleged lack of support for the "audio file" limitation.

Applicants submit that the prior Office Actions have failed to set forth a proper *prima facie* case of obviousness. None of the cited references, alone or in combination, includes the limitation that the web document be dynamically generated.

Both automatic and dynamic generation are required by claim 8. As discussed in the paper filed February 17, 2006, particularly on page 7, the information in Kobayakawa that is relied upon by the Examiner does not contemplate all of the limitations of the instant claims. Kobayakawa is limited to display of content by a translation engine. That translation engine is unrelated to the web page being translated. It is not a dynamically generated web page. Kobayakawa reports only a limited translator not capable of translation of graphics and sound. This is markedly different from the instant invention which, as claimed, allows insertion of varied graphics and sound files in addition to text files depending on the language in which the page is generated.

This is clearly not taught by Kobayakawa or any other reference related to mere analysis of an existing web page by a translation engine. Instead, the web pages as discussed in the instant case are generated automatically from variables that have been previously assigned by the web page designer (not by some arbitrary translation engine) to values in language A, language B, and perhaps other languages. As noted above, the panel is invited to please reconsider the arguments made on pages 6-9 of the February 17, 2006 paper. This argument is further explored in the paper filed August 18, 2005, in particular, on pages 7 and 8 of that case.

Kobayakawa further lacks motivation for combination with the cited references. In particular, please note the argument on page 8 of the February 17, 2006 paper, on page 9 of the paper filed March 4, 2005, and on page 8 of the paper filed on August 18, 2005. The panel is asked to please remember that merely because references can be combined does not necessarily mean that motivation to combine those references exists. That is the case here. Even if the references were able to be combined (something that Applicants do not admit), there is no motivation to do so.

II. Rejection Under 35 U.S.C. § 112

Claim 40 stands rejected under 35 U.S.C. § 112 for alleged inclusion of new matter based on the use of the term "audio file." Applicants maintain, as they did in their initial statement supporting the amendment, that support for this term may be found, for example, in the paragraph beginning on page 3, line 20, and in the paragraph beginning on page 11, line 5. No *in haec verba* support is required for addition of limitations to the claims.

III. Conclusion

Applicants have demonstrated, both above and throughout prosecution, that no *prima facie* case of obviousness has been created. The cited publications do not include all of the limitations of the claims, and there is no motivation for their combination. Therefore, the rejection for obviousness of all claims should be withdrawn and the claims allowed. In lieu of allowance of all claims, Applicants respectfully request that some claims be allowed and that prosecution be reopened for the remaining claims.

Respectfully submitted,

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